



2) 3639
PATENT
Customer No. 22,852
Attorney Docket No. 05725.0976-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Gilles RUBINSTENN) Group Art Unit: 3639
Application No.: 10/024,332) Examiner: Igor N. BORISSOV
Filed: December 21, 2001)
For: IDENTIFICATION AND) Confirmation No.: 4634
PRESENTATION OF ANALOGOUS)
BEAUTY CASE HISTORIES)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In an Office Action dated July 7, 2005, the Examiner required restriction under 35 U.S.C. § 121 between:

- Group I - Claims 1-40, characterized by the Examiner as being drawn to a method of assisting a customer in selecting a beauty product;
- Group II - Claims 41-50, characterized by the Examiner as being drawn to a method of evaluating age-progression and facial-reconstruction; and
- Group III - Claims 51-56, characterized by the Examiner as being drawn to a method for accessing a remote database containing text files or images.

Applicant provisionally elects **with traverse** to prosecute Group 1, claims 1-40.

Applicant traverses the restriction requirement under 35 U.S.C. § 121 for at least the following reasons.

The Office Action asserts that Groups I-III are allegedly related as subcombinations usable together in a single combination. *Office Action ("OA")*, p. 2. The Office Action also asserts that the subcombinations are allegedly distinct from each other because they are separately usable. *Id.* Contrary to the assertions in the Office Action there is absolutely no basis for making a "subcombination" restriction requirement. "A **combination** is an organization of which a **sub-combination** or element is a **part**." M.P.E.P. § 806.05(a) (emphasis added). Accordingly, multiple sub-combinations each must be a part of the same, single combination.

The Examiner has not provided any evidence demonstrating that Groups I-III are parts of a single combination. For example, the Examiner has not identified any combination for which Groups I-III are subcombinations. Accordingly, the Examiner has not presented a *prima facie* case providing any support for the assertion that Groups I-III are related as subcombinations usable together in a single combination, and thus, the restriction requirement should be withdrawn.

Further, "if the search and examination of an entire application can be made without serious burden, the examiner **must** examine it on the merits, even though it includes claims to independent or distinct inventions." M.P.E.P. § 803 (emphasis added).

The search required to properly examine the claims of one of Groups I-III would necessarily overlap a search required to properly examine the claims of the remainder of Groups I-III. For example, claim 51 of Group III would involve a search overlapping the search for claims of Group I, and claim 54 of Group III would involve a search

overlapping the search for claims of Group II. Accordingly, it would not constitute an undue burden to search all of the claim Groups together.

Applicant respectfully requests that the Examiner reconsider and withdraw the restriction requirement. If the Examiner declines to withdraw the restriction requirement, Applicant requests that the Examiner acknowledge Applicant's election with traverse and indicate the finality of the restriction requirement so that Applicant will be able to submit a Petition under 37 C.F.R. § 1.144 to the Group Director requesting review of this requirement.

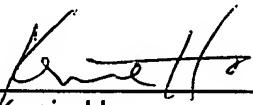
Finally, Applicant notes that the Office Action contains numerous statements reflecting apparent assertions concerning the claims. Regardless of whether any such statement is addressed specifically herein, Applicant declines to automatically subscribe to any assertion and/or characterization set forth in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 31, 2005

By: 
Kenie Ho
Reg. No. 51,808